

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of July 7, 2009 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 14-1437.

#### **Claim Rejections – 35 USC § 103**

In the Office Action, Claims 1-4, 8-10, 38-41, and 43-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,691,162 to Wick (hereinafter Wick) in view of U.S. Patent 7,266,776 to Quillen, *et al.* (hereinafter Quillen). Claims 5 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wick in view Quillen, and in further view of U.S. Patent 6,430,604 to Ogle, *et al.* (hereinafter Ogle).

Although Applicants respectfully disagree with the rejections, Applicants have amended the claims in an effort to even more clearly define the present invention and to facilitate prosecution of the instant application. The claim amendments are fully supported by the original disclosure and no new matter has been introduced.

#### **Aspects of Applicants' Invention**

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, as illustrated by Claim 1, is a method for automatically performing instant messaging actions.

The method can include displaying a user selectable list of subscribers in a graphical user interface of an instant messaging service; selecting a group of subscribers in an inactive state from the list in the graphical user interface, the inactive state being

any state where an instant messaging session cannot be established with a subscriber, types of inactive state including an offline state, a do-not-disturb state, and an out-of-office state; and displaying in the graphical user interface the subscribers in the selected group in a visually distinctive manner so that a user can identify the subscribers being monitored for a state change.

The method also can include displaying in the graphical user interface options of action to be performed when a subscriber in the selected group becomes active; and designating at least one action from the options of action for each type of inactive state via the graphical user interface, the at least one designated action to be automatically performed with respect to each subscriber in the group when the subscriber's state changes from the type of inactive state to an active state.

The method further can include monitoring a state change for each subscriber in the selected group; automatically detecting a state change of at least one of said subscribers in said group; and automatically executing the designated action associated with the at least one subscriber responsive to the detecting step.

See, e.g., Specification, paragraphs [0034]-[0037], and Figs. 3-4.

**The Claims Define Over The Prior Art**

It was stated in the Office Action that Quillen teaches selecting a group of inactive subscribers (Figs. 7c and 8) in an inactive state from the list of subscribers in the graphical user interface (col. 12, lines 37-39 and col. 10, lines 35-41).

It is noted that the icons 705, 820, 825, and 830 as shown in Figs. 7c and 8 represent a contact or a group of contacts. However, Quillen does not disclose that the contacts in the group are inactive subscribers. Quillen also does not disclose selecting inactive subscribers from a list of subscribers to form a group of inactive subscribers. It is described in col. 12, lines 37-39 of Quillen that a user can perform operations on any of

the icons 820, 825, or 830 to cause actions to be executed for the contact represented by the respective icon. It is unclear how this passage discloses selecting inactive subscribers from a list of subscribers to form a group of inactive subscribers. It is described in col. 10, lines 35-41 of Quillen that operations (such as setting an alert) may be performed on icon 520 to execute corresponding actions related to the contact represented by icon 520. Similarly, it is unclear how this passage discloses selecting inactive subscribers from a list of subscribers to form a group of inactive subscribers.

It is noted that in the present invention, the group of inactive subscribers is not shown as an icon; rather, the inactive subscribers selected from the list of subscribers are displayed in a visually distinctive manner so that a user can identify the subscribers being monitored for a state change (see, e.g., paragraph [0037] of the specification). This limitation is not disclosed by any of the cited references

Further, in the present invention each type of inactive state (such as an offline state, a do-not-disturb state, and an out-of-office state) can be designated with different actions via the graphical user interface so that the at least one designated action for a particular type of inactive state can be automatically performed with respect to each subscriber in the group when the subscriber's state changes from this particular type of inactive state to an active state (see, e.g., paragraph [0034] of the specification). This limitation is not disclosed by any of the cited references

Regarding Claims 3 and 40, the actions of sounding an alarm (step 54); sending an IM (step 55), opening a conversation window on the pouncer's client system (step 56); or executing a user-specified command (step 57) as shown in Fig. 5 of Wick are different from a notification action, a prompting action, and a message conveyance action, as recited in Claims 3 and 40.

Accordingly, the cited references, alone or in combination, fail to disclose or suggest each and every element of Claims 1, 38, and 45. Applicants therefore

respectfully submit that Claims 1, 38, and 45 define over the prior art. Furthermore, as each of the remaining claims depends from Claims 1 or 38 while reciting additional features, Applicants further respectfully submit that the remaining claims likewise define over the prior art.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

### **CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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